



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 017227-0157

In re patent application of

Ian R. DOYLE et al.

Serial No. 09/486,703

Filed: June 27, 2000

For: A METHOD OF DIAGNOSIS

Group Art Unit: 1645

Examiner: Patricia Ann Duffy

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper is a response to the restriction requirement set forth in the Office Action mailed on March 18, 2002. A response is due on September 18, 2002, by virtue of the attached Petition for Extension of Time and payment of the required fees. Although applicants believe that the amount of the attached check is correct, the Commissioner is hereby authorized to credit any overpayment or to charge any deficiency to Deposit Account No. 19-0741.

Applicants elect, with traverse, Group I, claims 1-12, drawn to methods of diagnosing lung damage by screening for modulation of pulmonary surfactant levels in a body fluid, and reserve the right to file a divisional application covering the subject matter of the non-elected claims.

The applicants traverse the Examiner's restriction requirement to the extent that the Examiner asserts that the Group I - Group V claims define separate and distinct inventions. Furthermore, the Examiner alleges that these claims do not relate to a single general inventive concept due to these claims not defining a novel feature over the prior art by citing the references detailed in the International Preliminary Examination Report. The Examiner alleges that these references teach the correlation of levels of pulmonary surfactant with lung damage.

Applicants respectfully submit that the Examiner's position in relation to the issuance of this restriction requirement is in contravention of the terms of the Patent Cooperation Treaty. Specifically, Article 27(1) of the PCT states that:

"No national law shall require compliance with requirements relating to the form or contents of the International application different from or in addition to those which are provided for in this Treaty and the regulations."

It necessarily follows that an International application's compliance with the unity of invention requirements laid down in Rule 13 *must be accepted by all designated and elected offices*. In other words, Article 27(1) does *not* allow any national law to require compliance with requirements relating to the contents of the International application *different from or additional to those* provided for in the PCT.

Applicants request the Examiner to consider the fact that, in the International Preliminary Examination Report, there was *no objection* raised to the unity of this invention. Please refer to Box 3 of the International Preliminary Examination Report, attached as Appendix A. ✓

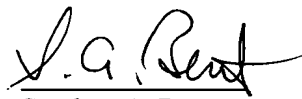
Applicants, therefore, respectfully request reconsideration of the Examiner's decision to subject this application to a restriction requirement on the grounds that the claimed invention has been clearly held to satisfy the unity requirements under the terms of the Patent Cooperation Treaty.

Receipt of the initial Office Action on the merits is awaited.

September 18, 2002
Date

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Respectfully submitted,


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